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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,606	01/12/2004	John J. Talley	01-092-F	4812
20306	7590	11/19/2004	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP			SHIAO, REI TSANG	
300 S. WACKER DRIVE			ART UNIT	
32ND FLOOR			PAPER NUMBER	
CHICAGO, IL 60606			1626	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,606

Applicant(s)

TALLEY ET AL.

Examiner

Robert Shiao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on responses filed on 09/15, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This application claims benefit of the application:
10/004,960 with a filing date December 04, 2001.
2. Amendment of claims 1-9 in the amendment filed on September 15, 2004, is acknowledged. Claims 1-17 are pending in the application.

Responses to Election/Restriction

3. Applicant's election without traverse of Group II claims 1-10, in part, in the reply filed on September 15, 2004, is acknowledged. The invention claims 1-10, in part, embraced in the scope of below elected subject matter, are prosecuted in the case. Claims 1-10, in part, not embraced in the scope of below elected subject matter, and claims 11-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

Status of the Claims

4. Claims 1-17 are pending in the application. The scope of the invention of the elected subject matter is as follows:

Claims 1-10, in part, drawn to compounds/compositions of formula (I), wherein the variable A represents pyrazolyl thereof; the variable Y does not represent heteroaryl, heterocycle moiety (i.e., heterocycle, heterocycloalkyl, heteroaryloxyalkyl, heteroaryloxy, etc), and the variable Y is not substituted with heteroaryl, heterocycle moiety (i.e., heterocycle, heterocycloalkyl, heteroaryloxyalkyl, heteroaryloxy, etc); the

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variable Ar does not represent heteroaryl or heterocycle, and the variable Ar is not substituted with heteroaryl or heterocycle, the variable R¹ does not represent heterocycle or heteroaryl, and R¹ is not substituted with heterocycle or heteroaryl, the variable R₂ is as defined in claim 1.

The invention claims 10-13, in part, embraced in above elected subject matter are prosecuted in the case. Claims 10-13, in part, not embraced in above elected subject matter, and claims 11-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, recites the limitation "pyrrolyl" of the variable A in line 2. There is insufficient antecedent basis for this limitation in the claim. The limitation "pyrrolyl" of the variable A is not found in the base claim. It is noted that the variable A of formula (I) is limited to "pyrazolyl" in claim 1.

Claim 7, recites the limitation "a compound of formula (II)" having variables R⁵ and R⁹, however, the limitation of R⁵ and R⁹ is not found. It is not clear what the

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limitation of variables R^5 and R^9 is. Moreover, the limitation " R^{10} " is not found in the compound of formula (II). Clarification is required, see page 17.

Claim Rejections - 35 USC § 102


6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-6, and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by Numata et al. WO 9614302, see CAS:125:114611.

Applicants claim compounds of formula (I) as agents treating inflammation.

Numata et al. disclose a compound Benzamide, 2-chloro-5-[[1-(4-fluorophenyl)-5-[4-(methylsulfonyl)phenyl]-1H-pyrazol-3-yl]carbonyl]-, clearly anticipate the instant compound of formula (I), wherein the variable A represents pyrazolyl, the variable Y represents , the variable R^1 represents aryl (i.e., phenyl) substituted with halo (i.e., fluoro), the variable R^2 represents alkyl (i.e., methyl), the variable Ar represents aryl (i.e., phenyl) substituted with two substituents selected from carbamoyl and halo (i.e., chloro), see RN: 179325-58-7.

Objection

7. Claims 1-10 are objected to as containing non-elected subject matter, i.e., heterocycloalkyl, heterocyclo, heterocyclyl, heteroaryl, heteroaryloxy, heteroarylthio, oxazolyl, thienyl, furyl, pyrrolyl, thiazolyl, imidazolyl, isoxazolyl, pyrazolyl, pyridyl, etc. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined on the elected subject matter of pages 2-3, *supra*.
8. Claim 10 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Robert Shiao, Ph.D.
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Art Unit 1626

November 17, 2004

